

REQUEST FOR RECONSIDERATION

Claims 1-21 are pending. Reconsideration is respectfully requested.

Applicants also respectfully disagree with all of the claim rejections. Nevertheless,

Applicants are willing to cancel claims 1-17 upon allowance of claims 18-21. As discussed in more detail later, claims 18-21 are allowable over the applied references.

The Amendment to the Drawings

Applicants respectfully disagree with the drawing objections. Nevertheless, the drawings (Figures 9 and 10) have been amended to advance prosecution, as requested. A Request to Amend Drawings is attached herewith. Thus, Applicants respectfully submit that the drawing objections should be withdrawn.

Applicants' traversals of the drawing objections remain. With regard to Figure 9, the reference characters 154 and 164 do not designate the *same* part. The specification is clear that the cam 154 is bounded by a cam surface 164 (e.g., page 22, line 17). This is further evidenced by Figures 7 and 10. The cam surface 164 is part of the cam 154. A line pointing to a cam's surface 164 would also be pointing to that cam 154.

With regard to Figure 10, the reference characters 94 and 80 do not designate the *same* part. The specification is clear that the picking member 72 has an outer bounding surface 80 (e.g., page 17, line 1; Figures 2-3). The specification is also clear that the picking member 72 has a shaft 88 and three separated cylindrical portions (central portion 90, first outboard portion 92, and second outboard portion 94) are supported on the shaft (e.g., page 19, lines 7-14; Figures 2-3). Figure 10 shows the outer surface of segment 144 moved to generally conform with the outer bounding surface 80 of the picking member 72. Figure 10 also shows outboard portion 94.

The 35 U.S.C. § 103 rejections of claims 18-21

Claims 18-21 were newly rejected as obvious pursuant to 35 U.S.C. § 103(a) over Graef (US 2004/0094889) in view of Sheng (US 2003/0122298).

Graef (US 2004/0094889) does not constitute prior art to the recited invention

This Graef application and the Graef reference (US 2004/0094889) were, at the time the invention was made, owned by, or subject to an obligation of assignment, to the same entity.

Subject matter developed by another person which only qualifies as prior art under 35 U.S.C. § 102(e) is disqualified as prior art under 35 U.S.C. § 103(a) where the subject matter and the claimed invention were subject to an obligation of assignment to the same entity at the time the invention was made. 35 U.S.C. § 103(c). MPEP § 706.02(l)(1).

In accordance with 35 U.S.C. § 103(c), Graef cannot preclude patentability of the present invention. Therefore, it is respectfully submitted that Graef is disqualified as prior art in relation to the present invention with regard to 35 U.S.C. § 103(a).

Applicants "may overcome a 35 U.S.C. § 103 rejection based on a combination of references by showing completion of the invention by applicant prior to the effective date of any of the references" (MPEP § 715.02). Therefore, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claims 18-21 should be withdrawn.

Conclusion

Again, Applicants are willing to cancel claims 1-17 upon allowance of claims 18-21 to place this application in condition for allowance. Failure by the Office to allow claims 18-21 will likely result in appeal of all claims. The undersigned is willing to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,


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D-1217 R3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Graef, et al.

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Application No.: **10/796,551**

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Art Unit 3651

Confirmation No.: **1996**

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Filed: **March 9, 2004**

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Patent Examiner

Leslie August Nicholson III

Title: **Cash Dispensing Automated
Banking Machine and Method**

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PO Box 1450
Alexandria, VA 22313-1450

Request to Amend Drawings

Sir:

Permission to amend the drawings is respectfully requested. Applicants request to amend the pending drawings by substituting one replacement sheet of drawing (containing formal Figures 9 and 10) for the currently pending sheet of drawing containing Figures 9 and 10. No new subject matter will be added as a result of this amendment.

In response to the Office Action dated March 20, 2006, Applicants have extended the line corresponding to reference numeral 154 in Figure 9 (in a manner similar to that already shown in Figure 10). Applicants have also added an arrow to the end of the line corresponding to reference numeral 80 in Figure 10 (in a manner similar to that already shown in Figures 2 and 3). Further discussion of this drawing amendment can be found in the remarks section of Applicants' Response.

Respectfully submitted,



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